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EXAMINER

HERRERA, DIEGO D

ART UNIT PAPER NUMBER

2617

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/743,374 | Applicant(s) ALA-LEHTIMAKI ET AL. | |
| | Examiner Diego Herrera | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/22/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Amendment

The examiner has made notice of the cancelled claim 1, also the amendments made to claims: 2, 6-14, & 19.

The examiner will also remove the rejection 35 USC 103 with Deeds in view of Pettine Jr. for claims 7, 17, & 24; the rejection 35 USC 103 with Deeds in view of Grams for claims 8, 18, & 25.

These changes will be made of record.

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., WLAN in claims 7-8, & 10-11) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the argued features are written broad such that they read upon the cited references or are claiming the same limitation as the cited references.

Even though the examiner does acquiesce to the lack of the reference of Deeds not being able to teach the limitations of claims 7 and 8, nevertheless, the deficiency of Deeds is covered by Pettine jr. and Grams references respectively, hence the rejection of 35 USC 103 (a).

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However, since the applicant has come forward with indication that the reference is owned by the assignee (Nokia Corporation) at the time the invention was made, the examiner retracts the 35 USC 103 (a). Applicant's arguments with respect to claims 7 & 8 have been considered but are moot in view of the new ground(s) of rejection.

Concerning claim 19, the insertion of WLAN into the claim does not overcome the rejection because the system used and discussed in Deeds uses WLAN inherently, the elements render the situation of having a Wireless Local Area Network otherwise the system of the invention in Deeds will not be possible, the elements also suggest WLAN and are well known in the art to facilitate WLAN (see paragraph 0005, & 0008).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9-16, 19-23, and 26 are rejected under 35 U.S.C. 102(e) as being unpatentable over Deeds (U.S. Pub. No. 2004/0203610 A1).

Regarding Claim 1. **Canceled.**

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Regarding Claim 2. Deeds teach wherein the user interface element includes a plurality of keys, and the processing unit is configured to receive key presses, which represent the shorthand for the destination (paragraph 0009 & paragraph 41).

Regarding Claim 3. Deeds teach wherein the shorthand for the destination includes a speed dialing number, which includes a plurality of dialing digits (paragraph 0047).

Regarding Claim 4. Deeds teaches wherein the processing unit is configured to interpret a key press of a key associated with the shorthand lasting longer than a predetermined time as the shorthand for the destination (paragraph 0047 (depressing the keys to activate speed dialing)).

Regarding Claim 5. Deeds teaches wherein the processing unit is configured to interpret a key press of a key associated with the shorthand followed by a key press of another key as the shorthand for the destination (paragraph 0041 (the user selects one or more keys after the designated "*" key as the function of speed dialing)).

Regarding Claim 6. Deeds teach wherein the user interface element includes a microphone, and the processing unit is configured to recognize voice as the shorthand for the destination (paragraph 0031, Lines 1-5 & Fig. 1, Items 90 and 100 & paragraph 0039, Lines 1 1-27).

Regarding Claim 9. Deeds teach wherein the electronic message with user-defined contents includes a data message (paragraph 0030, Lines 9-14).

Regarding Claim 10. Deeds teaches a terminal of a radio communication system for transmitting an electronic message with user-defined contents (paragraph 0008 & paragraph 0016 & Fig. 2), the terminal comprising:

A wireless transceiver (paragraph 0027, Lines 1-2);

A user interface element (paragraph 0009 & paragraph 0031, lines 1-2); and

A processing unit coupled to the wireless transceiver and the user interface element, configured to receive an input defining the contents of the electronic message from the user interface element, to receive a shorthand for a destination of the electronic message from the user interface element, to associate the shorthand for the destination with a full destination, and to transmit the message with user-defined contents to the full destination utilizing the wireless transceiver (paragraph 0047);

Wherein the electronic message with user-defined contents is, a
Multimedia Message Service MMS message (paragraph 0026).

Regarding Claim 11. Deeds teaches a terminal of a radio communication system for transmitting an electronic message with user-defined contents (paragraph 0008 & paragraph 0016 & Fig. 2), the terminal comprising:

A wireless transceiver (paragraph 0027, Lines 1-2);

A user interface element (paragraph 0009 & paragraph 0031, lines 1-2); and

A processing unit coupled to the wireless transceiver and the user interface element (paragraph 0027, Lines 1-5 & Fig. 1, Items 80, 60, 70, 140, 110 & paragraph 0030, lines 1-9),

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configured to receive an input defining the contents of the electronic message from the user interface element (paragraph 0049, Lines 15-31), to receive a shorthand for a destination of the electronic message from the user interface element, to associate the shorthand for the destination with a full destination, and to transmit the message with user-defined contents to the full destination utilizing the wireless transceiver (paragraph 0047);

Wherein the electronic message with user-defined contents is one of a digital image or drawing created by means of a camera or a touch pad coupled to the terminal, a digital sound recording, a digital representation of sound, a file, data inputted over a serial data interface, material inputted to the terminal from a device external to the terminal (paragraph 0049, Lines 15-31).

Regarding Claim 12. Deeds teaches wherein the full destination defines one of a subscriber identifier of the radio Communication System, a group of subscriber identifiers of the radio communication system, an e-mail address, a group of email addresses, another terminal of the radio communication system, a computer, an Internet Protocol IP address (paragraph 0060, Lines 1-5).

Regarding Claim 13. Deeds teaches a terminal of a radio communication system for transmitting an electronic message with user-defined contents (paragraph 0008 & paragraph 0016 & Fig. 2), the terminal comprising:

A wireless transceiver (paragraph 0027, Lines 1-2);

A user interface element (paragraph 0009 & paragraph 0031, lines 1-2); and

A processing unit coupled to the wireless transceiver and the user interface element (paragraph 0027, Lines 1-5 & Fig. 1, Items 80, 60, 70, 140, 110 & paragraph 0030, lines 1-9), configured to receive an input defining the contents of the electronic message from the user interface element (paragraph 0049, Lines 15-31), to receive a shorthand for a destination of the electronic message from the user interface element, to associate the shorthand for the destination with a full destination, and to transmit the message with user-defined contents to the full destination utilizing the wireless transceiver (paragraph 0047);

Wherein the wireless transceiver includes a Wireless Local Area Network WLAN transceiver (paragraph 0027, lines 1-2 & paragraph 0033 & paragraph 0029).

Regarding Claim 14. Deeds teach a terminal of a radio communication system for transmitting an electronic message with user-defined contents (paragraph 0008 & paragraph 0016 & Fig. 2), the terminal comprising: wireless transmitting means for transmitting an electronic message with user-defined contents via a Wireless Local Area Network (WLAN) (paragraph 0027, Lines 1-2), user interface means for interacting with a user of the terminal (paragraph 0009 & paragraph 0031, lines 1-2), and processing means for receiving an input defining the contents of the electronic message from the user interface means (paragraph 0027, Lines 1-5 & Fig. 1, Items 80, 60, 70, 140, 110 & paragraph 0030, Lines 1-9), for receiving a shorthand for a destination of the electronic message from the user interface means, for associating the shorthand for the destination with a full destination, and for transmitting the message with user-defined contents to the full destination utilizing the wireless transmitting means (paragraph 0047).

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Regarding Claim 15. Deeds teaches wherein the user interface means include keying means, and the processing means are configured to receive key presses, which represent the shorthand for the destination (paragraph 0009 & paragraph 41).

Regarding Claim 16. Deeds teaches wherein the user interface means include voice- capturing means, and the processing means are configured to recognize voice as the shorthand for the destination (paragraph 0031, Lines 1-5 & Fig. 1, Items 90 and 100 & paragraph 0039, Lines 11-27).

Regarding Claim 19. Deeds teach a method for transmitting an electronic message with user-defined contents utilizing a terminal of a radio communication system (paragraph 0008 & paragraph 0016 & Fig. 2), the method comprising: receiving an input defining the contents of the electronic message (paragraph 0049, Lines 15-31), receiving a shorthand for a destination of the electronic message, associating the shorthand for the destination with a full destination, and wirelessly transmitting the message over a Wireless Local Area Network (WLAN) via a WLAN transceiver with user-defined contents to the full destination (paragraph 0047).

Regarding Claim 20. Deeds teach wherein the reception of the shorthand for the destination of the electronic message includes: receiving key presses, which represent the shorthand for the destination (paragraph 0009 & paragraph 41).

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Regarding Claim 21. Deeds teach wherein the method further comprises: interpreting a key press of a key associated with the shorthand lasting longer than a predetermined time as the shorthand for the destination (paragraph 0047 (depressing the keys to activate speed dialing)).

Regarding Claim 22. Deeds teach wherein the method further comprises: interpreting a key press of a key associated with the shorthand followed by a key press of another key as the shorthand for the destination (paragraph 0041 (the user selects one or more keys after the designated "*" key as the function of speed dialing)).

Regarding Claim 23. Deeds teach wherein the reception of the shorthand for the destination of the electronic message includes: recognizing voice as the shorthand for the destination (paragraph 0031, Lines 1-5 & Fig. 1, Items 90 and 100 & paragraph 0039, Lines 1 1-27).

Regarding Claim 26. Deeds teaches wherein the method further comprises at least one of: creating a text message as the electronic message with user-defined contents', creating a digital image or drawing as the electronic message with user-defined contents', creating a digital sound recording as the electronic message with user-defined contents', creating a digital representation of sound as the electronic message with user-defined contents', creating a file as the electronic message with user defined contents, receiving data inputted over a serial data interface as the electronic message with user-defined contents', receiving material from a device external to the terminal as the electronic message with user-defined contents (paragraph 0049, lines 15-31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7, 14, 17, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US PATENT 6256516 B1) in view of Pettine Jr. (U.S. Pub. No. 2004/0198354 A1).

Regarding Claim 7. Wagner teaches a terminal of a radio communication system for transmitting an electronic message with user-defined contents (abstract, title), the terminal comprising:

A wireless transceiver (fig. 2, abstract, title);

A user interface element (fig. 2, 3a); and

A processing unit coupled to the wireless transceiver and the user interface element (fig. 2, 3a, col. 1 lines: 31-40, & 46-54, Wagner teaches the unit which process information with the user interface to transmit & receive information), configured to receive an input defining the contents of the electronic message from the user interface element (fig. 2, 3a, key pad, user display), to receive a shorthand for a destination of the electronic message from the user interface element, to associate the shorthand for the destination with a full destination (fig. 3a-3b, speed-dial), and to transmit the message with user-defined contents to the full destination utilizing the wireless transceiver (fig. 2, transceiver shown);

However, Wagner et al does not disclose wherein the user interface element includes a touch pad, and the processing unit is configured to recognize a special touch as the shorthand for the destination.

In the same field of endeavor, Pettine Jr. discloses a communication address re- direction system for a mobile communication device wherein the user interface element includes a touch pad, and the processing unit is configured to recognize a special touch as the shorthand for the destination (paragraph 0047, Lines 1-13).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the terminal of Wagner et al., the touch screen and speed dial function as taught by Pettine Jr. in order to have a shorthand method available through touch.

Regarding Claim 14. Wagner et al. discloses a terminal of a radio communication system for transmitting an electronic message with user-defined contents (title, abstract), the terminal comprising:

Wireless transmitting means for transmitting an electronic message with user-defined contents via a Wireless Local Area Network (WLAN) (fig. 2, title, abstract, col. 1 lines: 15-54; Wagner shows capability of transmitting means for wireless system), user interface means for interacting with a user of the terminal (fig. 2, col. 3 lines: 9-15, Wagner teaches keypad is used for interface with GUI and screen to do so), and processing means for receiving an input defining the contents of the electronic message from the user interface means (fig. 2, col. 3 lines: 42-48, Wagner teaches processing circuitry for interface means), for receiving a shorthand for a destination of the electronic message from the user interface means (fig. 3a-3b, col5 lines:52-67, Wagner teaches speed dial & redial capabilities, hence, short hand for full destination), for associating the shorthand for the destination with a full destination (fig. 3a-7; col. 3 lines: 57-67—col. 4 lines: 1-6, Wagner teaches the processing power of processor), and for transmitting the message with user-defined contents to the full destination utilizing the wireless transmitting means (fig. 3a-3b, col5 lines:52-67, Wagner teaches speed dial & redial capabilities, hence, short hand for full destination).

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Regarding Claim 17. Wagner et al.; however, does not teach specifically wherein the user interface means include touch-sensing means, and the processing means are configured to recognize a special touch as the shorthand for the destination.

In the same field of endeavor, Pettine Jr. discloses a communication address re- direction system for a mobile communication device wherein the user interface means include touch-sensing means, and the processing means are configured to recognize a special touch as the shorthand for the destination (paragraph 0047, Lines 1-13).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the terminal of Wagner et al., the touch screen and speed dial function as taught by Pettine Jr. in order to have a shorthand method available through touch.

Regarding Claim 19. Wagner et al. teaches a method for transmitting an electronic message with user-defined contents utilizing a terminal of a radio communication system (abstract, title, fig. 2-3b), the method comprising: receiving an input defining the contents of the electronic message (fig. 6, col. 6 lines: 53-67—col. 7 lines: 1-23, Wagner teaches the input of contents of an electronic message), receiving a shorthand for a destination of the electronic message, associating the shorthand for the destination with a full destination (abstract, title, col. 5-7, Wagner teaches the ability to resend to sender as a reply has been render), and wirelessly transmitting the message over a Wireless Local Area Network (WLAN) via a WLAN transceiver with user-defined contents to the full destination (title, abstract, fig. 2, wireless transceiver).

Regarding Claim 24. Wagner et al. teaches wherein the reception of the shorthand for the destination or the electronic message (title, abstract, fig. 2, 3a, Wagner teaches the redial, speed dial and processor to carry out such events inputted by user or subscriber); however, fails to specifically recognizing a special touch of a touch- sensitive area of the terminal as the shorthand for the destination.

In the same field of endeavor, Pettine Jr. discloses a communication address re-direction system for a mobile communication device wherein the reception of the shorthand for the destination or the electronic message includes: recognizing a special touch of a touch-sensitive area of the terminal as the shorthand for the destination (paragraph 0047, Lines 1-13).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the terminal of Wagner et al., the touch screen and speed dial function as taught by Pettine Jr. in order to have a shorthand method available through touch.

Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US PATENT 6256516 B1) in view of Grams (U.S. Pub. No.2004/0259591 A1).

Regarding Claim 8. Wagner et al. teaches a terminal of a radio communication system for transmitting an electronic message with user-defined contents (abstract, title), the terminal comprising:

A wireless transceiver (fig. 2, abstract, title);

A user interface element (fig. 2, 3a); and

A processing unit coupled to the wireless transceiver and the user interface element (fig. 2, 3a, col. 1 lines: 31-40, & 46-54, Wagner teaches the unit which process information with the user interface to transmit & receive information), configured to receive an input defining the

contents of the electronic message from the user interface element (fig. 2, 3a, key pad, user display), to receive a shorthand for a destination of the electronic message from the user interface element, to associate the shorthand for the destination with a full destination (fig. 3a-3b, speed-dial), and to transmit the message with user-defined contents to the full destination utilizing the wireless transceiver (fig. 2, transceiver shown);

However, Wagner et al. does not teach wherein the user interface element includes a motion- sensing device, and the processing unit is configured to recognize a special motion as the shorthand for the destination.

In the same field of endeavor Grams discloses a gesture-based interface and method for wireless device wherein the user interface element includes a motion-sensing device, and the processing unit is configured to recognize a special motion as the shorthand for the destination (paragraph 0092).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the terminal of Wagner et al., the motion detector as taught by Grams in order to have a shorthand method available through the detection of motion.

Claims 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (US PATENT 6256516 B1); in view of Pettine Jr. (U.S. Pub. No. 2004/0198354 A1), and further in view of Grams (U.S. Pub. No.2004/0259591 A1).

Regarding Claim 18. Wagner et al. & Pettine jr.; however, fails to specifically teach wherein the user interface means include motion-sensing means, and the processing means are configured to recognize a special motion as the shorthand for the destination.

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In the same field of endeavor Grams discloses a gesture-based interface and method for wireless device wherein the user interface means include motion-sensing means, and the processing means are configured to recognize a special motion as the shorthand for the destination (paragraph 0092).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the terminal of Wagner et al. & Pettine jr., the motion detector as taught by Grams in order to have a shorthand method available through the detection of motion.

Regarding Claim 25. Wagner et al. & Pettine jr.; however, fail to specifically teach recognizing a special motion as the shorthand for the destination.

In the same field of endeavor Grams discloses a gesture-based interface and method for wireless device wherein the reception of the shorthand for the destination of the electronic message includes: recognizing a special motion as the shorthand for the destination (paragraph 0092).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the terminal of Wagner et al. & Pettine jr., the motion detector as taught by Grams in order to have a shorthand method available through the detection of motion.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diego Herrera whose telephone number is (571) 272-0907. The examiner can normally be reached on Monday-Friday, 6:30AM-3:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid G. Lester can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DH


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SUPERVISORY PRIMARY EXAMINER